

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/685,192

Filing Date: 10/14/2003

Applicant(s): Duncan L. Mewherter, Amy D. Travis, Koah-Hsing Wang
and Robert C. Weir

Entitled: RETRIEVING SLIDE SHOW CONTENT FROM
PRESENTATION DOCUMENTS

Examiner: Debrow, James J.

Group Art Unit: 2176

Attorney Docket No.: LOT920030025US1 (7321-010U)

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated January 23, 2009.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of November 3, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of November 3, 2008, and the arguments set forth below.

In response to the argument set forth on pages 5 and 6 of the Appeal Brief in which Appellants argued,

Appellants' claim 16 recites a "machine readable storage having stored thereon a computer program for converting a slide show presentation for use within a non-presentation application." As set forth in claim 16, the computer program includes a routine set of instructions for causing the machine to perform the same steps of claim 6 which is a method claim recited steps for converting a slide show presentation for use within a non-presentation application. Of note, the term "machine readable storage" is a term well-known in the art which has a plain meaning commonly associated with a storage medium able to be read by a machine such as a computer.

Examiner responded on page 17 of the Examiner's Answer:

The Examiner notes to the Honorable Board that the Examiner set forth a "claim" objection" against Claim 16, as can be seen above. For some unknown reason, the Appellant has converted the claim objection to a "claim rejection."

The Examiner further notes, as recited in MPEP 706.01, the practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Director of the USPTO. Thus, the Examiner will not respond to the rejection set forth by the Appellant.

Thus, Examiner appears to confirm that Examiner has "objected" to Appellants' specification for "failing to provide proper antecedent basis". Appellants' arguments within the Appeal Brief remain pertinent to the core of Examiner's "objection" and to that extent, Appellants respectfully request Examiner to consider the arguments of the Appeal Brief with respect to the "objection" if and when the present application re-enters prosecution following a resolution on the merits of the present appeal--namely that indeed Appellants' specification provides ample support for the claimed subject matter of Appellants' patent application.

In response to Appellants' arguments of page 8 of the Appeal Brief in which Appellants stated,

Applicants have clearly established that the slide show conversion process both extracts data from a slide show in its native format, and also converts associated slides in the slide show to raster imagery--a blatant transformation of a an article or physical object to a different state or thing.

Examiner responded on page 18 through 20 of the Examiner's Answer with four separate arguments:

(1) The "slide show" and the "slide show conversion process" are the only two components of the recited "system." Neither the "slide show" component nor the "slide show conversion process" component necessarily includes a computer hardware component. Rather, as claimed, the "slide show" component is electronic data and the "slide show conversion process" component is an algorithm of computer instructions (i.e., electronic commands).

(2) Bilski does not hold that any claim reciting an algorithm or process recites statutory subject matter when the claim operates to transform an article or physical object to a different state or thing. Rather, Bilski holds that a process claim recites statutory subject matter when the claim operates to transform an article or physical object to a different state or thing. As indicated in the above discussion, Claim 1 set forth a "system" and is thus not a process claim.

(3) Thirdly, in regard to MPEP 2106.01, Appellant ignores the most import part, which states:

"USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine" (emphasis added).

The "computer program" component (i.e., the recited "slide show conversion process") of Claim 1 is not being claimed as part of an otherwise statutory manufacture or machine, because the recited "system" of Claim 1 does not include a computer hardware component.

(4) Fourthly, in regard to Appellant's statement that converting the slides to raster imagery is a blatant transformation of an article or physical object to a different state or thing, the Appellant is wrong. In the context of the invention recited in Claim 1, the "slides" and the "raster imagery" are simply electronic data. Electronic data, in the abstract, is neither an article nor a physical object.

Examiner's rebuttal of pages 18 through 20 provide the assertion that claim 1 is necessarily a system claim (see second argument), yet Examiner at the same time asserts that a "system" does not fit into a statutory category.

Examiner's reasoning requires that in order to fall within a statutory category of subject matter, a claim must recite a "computer hardware component". Appellants are aware of no such statutory or judicial guidance that requires the presence of a *computer hardware component* to render a system claim statutory and Examiner provides no legal support for such an assertion. Further, Examiner interprets the holding in In re Bilski to require the recitation within the preamble of a claim of a process. Bilski provides no such guidance and merely states that a claim reciting a process must meet the machine or transformation test. Appellants have established that requisite transformation on page 8 of the Appeal Brief.

Yet further, Examiner argues that because a "hardware component" is not present, claim 1 is not being claimed as part of an otherwise statutory [article of] manufacture or machine. Examiner appears to read into M.P.E.P. 2106.01 "hardware component" when in fact M.P.E.P. 2106.01 refers to a statutory article or physical object with no such hardware component requirement. Finally, Examiner provides the naked assertion that because an article is not physically transformed, claim 1 does not meet the machine or transformation test of Bilski. Yet, Bilski does not require the transformation of a physical article, but a transformation of a physical article or data representative of a physical article.

Specifically, as to the transformation branch of the Bilski inquiry, the court explained that transformation of a particular article into a different state or thing "must be central to the purpose of the claimed process."¹ As to the meaning of "article," the court explained that chemical or

¹ Id. at 962.

physical transformation of physical objects or substances is patent-eligible under § 101.² The court also explained that transformation of data is sufficient to render a process patent-eligible if the data represents physical and tangible objects, i.e., transformation of such raw data into a particular visual depiction of a physical object on a display.³ In fact, Appellants' claim 1 recites the transformation of slides in a slide show to raster imagery and meets the test of transforming data because the data represents physical and tangible objects--a slide show.

In response to Appellants' arguments of pages 10 and 11 of the Appeal Brief in which Appellants stated,

Examiner has applied an unduly broad and actually contrarian meaning to the term "raster imagery" in comparing claim 1 to paragraphs [0111] and [0118] of Erol. Specifically, paragraphs [0111] and [0118] of Erol exclusively relate to optical character recognition in which raster imagery of a document is converted into textual data

Examiner responded on pages 20 through 21 of the Examiner's Answer:

Firstly, in regard to the recited "contextual data" that is extracted from the slide show in its native format, the Specification expressly states that contextual elements can include text extracted from the slide show presentation (see Pages 8 9, spanning sentence).

Thus, Examiner appears to have not rebutted Appellants' assertion that Examiner has committed reversible error in improperly construing "raster imagery" as "textual data". Instead, Examiner focuses on the claim construction of "contextual data"-- a term not brought into contention by Appellants in the Appeal Brief.

² Id.

³ Id. at 963.

Additionally, in response to Appellants' arguments of page 11 of the Appeal Brief in which Appellants stated,

Erol provides a teaching of converting raster imagery into non-raster imagery (text). Yet, the plain language of claim 1 (and also claims 6 and 16) require the conversion of contextual data (non-raster imagery) in a slide show into raster imagery--the opposite of the teachings of Erol.

Examiner responded on page 22 of the Examiner's Answer:

Secondly, in response to Appellant's argument that the reference fails to show conversion of contextual data (non-raster imagery) in a slide show into raster imagery), the examiner notes that converting "non-raster" imagery into "raster" imagery is not recited in the rejected claims.

Thus, Examiner's rebuttal of page 22 provides the assertion that the converting non-raster imagery into raster imagery is not recited in the rejected claims. Examiner is wrong. Appellants' claims clearly recite converting slides in a slide show into raster imagery. Necessarily, by the plain language of Appellants' claims, a conversion process converts one thing (slides) into another thing (raster imagery) deductively resulting in the conversion of imagery that is non-raster in nature to imagery that is raster in nature. To be sure, one cannot convert raster imagery into raster imagery because to do so would obviate the meaning of "convert".

For the reasons set forth in the Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 102(e) and 103(a)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: March 23, 2009

Respectfully submitted,

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